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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/815,616 | 04/02/2004 | Kia Silverbrook | HYG015US | 9410 |

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| EXAMINER | |
|---|---|
| KIM, TAE W | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2876 | |

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/815,616 | SILVERBROOK ET AL. | |
| | Examiner | Art Unit | |
| | Tae W. Kim | 2876 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *02 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/1/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "identity of the product item". There is insufficient antecedent basis for this limitation in the claim. Claim 4 is rejected for being dependent on the rejected and indefinite claim.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim(s) 1, 2, 5, 6, 11, 12, 14, 15, 17, 18, and 23-28 is/are rejected under 35 U.S.C. 102(b) as being anticipated by Axelrod (US 5337358).

Re claim 1: Axelrod discloses a card for identifying a user to a computer system using a sensing device (fig parts C & 24), the card having an interface surface having disposed thereon

or therein coded data (fig parts CB & CF), the coded data including a plurality of coded data portions, each coded data portion being indicative of an identity of the user (col 3 lines 15-22), the sensing device being adapted to:

(a) sense at least one coded data portion (fig parts CB);

(b) generate, using the at least one sensed coded data portion, indicating data indicative of the identity of the user (col 1 lines 45-55, col 3 lines 7-22); and,

(c) transfer the indicating data to the computer system, the computer system being responsive to determine, using the indicating data, the identity of the user (fig part 20, col 1 lines 45-55, col 2 line 63 - col 3 line 2, col 3 lines 7-22 & 29-44, col 4 lines 32-34).

Re claims 2 & 15: Axelrod discloses the card of claim 1 and the method of claim 12, wherein each coded data portion is provided at a respective position on the interface surface (fig parts CB & CF), and wherein the sensing device (fig part 24) generates indicating data indicative of at least one of:

(a) a position of the sensed coded data (col 5 lines 1-5);

(b) a position of the sensing device relative to the interface surface;

(c) an orientation of the sensed coded data; and,

(d) an orientation of the sensing device relative to the interface surface.

Re claims 5 & 17: Axelrod discloses the card of claim 1 and the method of claim 12, wherein the coded data distinguishes the identity of the user from the identity of every other user known to the computer system (col 1 lines 60-68, col 2 lines 40-44, col 4 lines 59-63: police officer distinguishes the identity of the driver from the identity of every other driver known to the system.).

Re claims 6 & 18: Axelrod discloses the card of claim 1 and the method of claim 12, wherein the coded data is redundantly encoded (col 3 lines 33-66).

Re claim 11, 23, & 26: Axelrod discloses the card of claim 1, the method of claim12, and the method of claim 24, wherein the coded data is disposed or the method includes disposing the coded data portion over a substantial portion of the interface surface (fig part CB).

Re claim 12: Axelrod discloses the method of using a card for facilitating interaction between a user and a computer system, the card having an interface surface having disposed thereon or therein coded data (fig parts CB & CF), the coded data including a plurality of coded data portions, each coded data portion being indicative of an identity of the user (col 3 lines 15-22), wherein the method includes in a sensing device:

(a) sensing at least one coded data portion when the sensing device is placed in an operative position relative to the interface surface (fig parts CB & 24);

(b) generating, using the at least one sensed coded data portion, indicating data indicative of the identity of the user (col 1 lines 45-55, col 3 lines 7-22); and,

(c) transferring the indicating data to the computer system, the computer system being responsive to the indicating data to perform an action (fig parts 20 & 36, col 2 line 63 - col 3 line 2 ; col 4 lines 1-5, 21-24, and 32-34 discloses actions such as displaying and recording.).

Re claim 14: Axelrod discloses the method of claim 12, wherein the method includes, in the computer system:

(a) receiving the indicating data from the sensing device (fig parts 24); and,

(b) determining, using the received indicating data, user identity data indicative of the identity of the user (col 1 lines 45-55, col 3 lines 7-22); and,

(c) performing the action using the user identity data (col 4 lines 1-5, 21-24, and 32-34 discloses actions such as displaying and recording.).

Re claim 24: Axelrod discloses a method of creating a card for facilitating interaction between a user and a computer system, the method including, in a computer system:

(a) receiving information indicative of an identity of the user (fig parts 20, col 1 lines 45-55, col 3 lines 7-22);

(b) generating at least one coded data portion indicative of the identity of the user (col 1 lines 45-55, col 3 lines 7-22); and,

(c) disposing coded data on an interface surface of the card (fig parts CB & CF), the coded data including a plurality of the coded data portions disposed to thereby allow the identity of the user to be determined (col 3 lines 15-22) by sensing any one of the data portions with a sensing device (fig part 24).

Re claim 25: Axelrod discloses the method of claim 24, the method including printing the coded data portions (fig part 42, col 4 lines 43-45).

Re claim 27: Axelrod discloses the method of claim 24, wherein the method further includes disposing visible information on the interface surface (fig parts CF & T, col 2 lines 10-15 col 3 lines 11-15).

Re claim 28: Axelrod discloses the method of claim 27, the visible information including at least one of:

(a) user information (fig parts I & T, col 3 lines 11-15);

(b) the user's name;

(c) a logo of a retailer;

(d) security information; and,

(e) a name of a retailer.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim(s) 7 and 19 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Axelrod (US 5337358) in view of Tame (US 20040026502).

Re claim 7 & 19: Axelrod discloses the card of claim 1 and the method of claim 12.

However Axelrod does not disclose or fairly suggest that the coded data is redundantly encoded using Reed-Solomon encoding.

Tame however discloses that the coded data is redundantly encoded using Reed-Solomon encoding (fig 2 par. 0046).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Tame's teaching that the coded data is redundantly encoded using Reed-Solomon encoding to the Axelrod's card and method for the advantage of using Reed-Solomon codes that the probability of an error remaining in the decoded data is usually lower than the probability of an error if Reed-Solomon is not used.

7. Claim(s) 8-10 and 20-22 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Axelrod (US 5337358) in view of Dougherty (US 6076734).

Re claim 8 & 20: Axelrod discloses card of claim 1 and the method of claim 12. However, Axelrod does not disclose or fairly suggest that the coded data is substantially invisible to the unaided eye.

Dougherty however discloses that the coded data is substantially invisible to the unaided eye (col 5 lines 32-40, col 9 lines 33-36).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Dougherty's teaching that the coded data is substantially invisible to the unaided eye to the Axelrod's card and method for the purpose of ensuring that the coded data is protected from unauthorized reading.

Re claim 9 & 21: Axelrod discloses the card of claim 1 and the method of claim 12.

However, Axelrod does not disclose or fairly suggest that the coded data is printed using infrared ink.

Dougherty however discloses that the coded data is printed using infrared ink (col 2 lines 59-64, col 4 lines 18-23, col 5 lines 32-58, col 10 lines 39-45).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Dougherty's teaching that the coded data is printed using infrared ink to Axelrod's card and method for the purpose of ensuring that the coded data is protected from unauthorized reading.

Re claim 10 & 22: Axelrod discloses the card of claim 1 and the method of claim 12.

However, Axelrod does not disclose or fairly suggest that the coded data is provided on the interface surface coincident with visible markings.

Dougherty however discloses that the coded data is provided on the interface surface coincident with visible markings (fig 1 parts 32 & 34, col 2 lines 43-58, col 5 lines 48-62).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Dougherty's teaching that the coded data is provided on the interface surface coincident with visible markings to Axelrod's card and method for the purpose of indicating positions of the encoded data.

8. Claim(s) 13 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Axelrod (US 5337358) in view of Ogasawara (US 6386450).

Re claim 13: Axelrod discloses the method of claim 12, wherein the method includes, in the computer system:

(a) receiving the indicating data from the sensing device

However, Axelrod does not disclose or fairly suggest that

(b) using the indicating data, at least one of:

(i) associating the scanner with the user; and,

(ii) dissociating the scanner and the user.

Ogasawara however discloses that

(b) using the indicating data, at least one of:

(i) associating the scanner with the user (col 10 lines 30-46); and,

(ii) dissociating the scanner and the user.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Ogasawara's teaching that (b) using the indicating data, (i) associating the scanner with the user to Axelrod's method for the purpose of enabling accounting and tracking of activity of each user.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae W. Kim whose telephone number is (571)272-5971. The examiner can normally be reached on Mon-Fri 7AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571)272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

STEVEN S. PAIK
PRIMARY EXAMINER

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